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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,295	12/11/2000	George Bradley Hobbs	10003974-1	3877

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O.Box 272400
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EXAMINER

EBRAHIMI DEHKORDY, SAEID

ART UNIT	PAPER NUMBER
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2625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)
	09/734,295	HOBBS, GEORGE BRADLEY
	Examiner	Art Unit
	Saeid Ebrahimi-dehKordy	2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 December 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 11-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 11-14, 16-24 AND 26-32 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____.

Response to Arguments

1. Applicant's arguments with respect to claims 11-21 and 24-32 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 11-15, 16-21, 26-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawai et al (U.S. patent 6,404,994)

Regarding claim 11 and 19 Kawai et al disclose: A method of processing a print job of a customer and including advertising with the print job; the method comprising the steps of: defining a print processing system controller having a plurality of advertisements registered therewith (note abstract, lines 12-15, also note column 6, Fig.4, lines 49-53) each of the advertisements having a profile associated therewith (note Abstract, lines 16-18 where the

copying machine displays a plurality of printable selection candidates from the plurality of advertisements) defining a network communication link between the customer and the print processing system controller (note column 8 lines 25-35, where the coping machines are connected to the customer through the network) receiving a data file for the print job from the customer at the print processing system controller via the network communication link (note again column 8 lines 25-35) processing the data file for the print job and determining from the data file a content of the print job (note column 8, lines 49-62, also note column 9 lines 23-34) and associating at least one of the advertisements with the print job (note column 8 lines 52-57) including automatically selecting the at least one of the advertisements based on the content of the print job and the profile of the advertisements (note column 16 lines 4-13, also note column 10 lines 49-58).

Regarding claim 12 Kawai et al disclose: The method of claim 11, wherein the step of defining the network communication link includes defining an Interact communication link between the customer and the print processing system controller (note column 8 lines 25-35).

Regarding claim 13 Kawai et al disclose: The method of claim 11, wherein the step of associating the at least one of the advertisements includes comparing the content of the print job with the profile of the advertisements and associating the at least one of the advertisements with the print job if the content of the print job coincides with the profile of the at least one of the advertisements (note column 8 lines 46-63).

Regarding claim 14 Kawai et al disclose: The method of claim 11, further comprising the step of printing the print job and wherein the step of associating the at least one of the advertisements

includes printing the at least one of the advertisements with the print job (note column 5 lines 37-59).

Regarding claim 16 Kawai et al disclose: The method of claim 11, further comprising the step of: registering the advertisements with the print processing system controller (note abstacte).

Regarding claim 17 Kawai et al disclose: The method of claim 16, wherein the step of defining the network communication link includes defining the network communication link between at least one advertiser, the customer, and the print processing system controller and wherein the step of registering the advertisements includes registering at least one advertisement of the at least one advertiser with the print processing system controller via the network communication link (note column 8 lines 25-35).

Regarding claim 18 Kawai et al disclose: The method of claim 16, wherein the step of registering the advertisements includes storing the advertisements and wherein the step of associating the at least one of the advertisements includes retrieving the at least one of the advertisements (note abstract, also note column 9 lines 23-34).

Regarding claim 20 Kawai et al disclose: The system of claim 19, wherein the print processing system controller is configured to communicate with the customer via a network communication link, and wherein the print processing system controller is adapted to receive the data file for the print job from the customer via the network communication link (note column 8 lines 25-35).

Regarding claim 21 Kawai et al disclose: The system of claim 20, wherein the network communication link is an Internet communication link (note column 8 lines 25-35).

Regarding claim 24 Kawai et al disclose: The system of claim 19, wherein the print processing system controller is adapted to compare the content of the print job with the profile of the

advertisements and associate the at least one of the advertisements with the print job if the content of the print job coincides with the profile of the at least one of the advertisements (note column 8 lines 46-65).

Regarding claim 26 Kawai et al disclose: The system of claim 19, wherein the print processing system controller is configured to communicate with at least one advertiser via a network communication link and wherein the print processing system controller is adapted to receive at least one advertisement of the plurality of advertisements from the at least one advertiser via the network communication link (note column 8 lines 25-35).

Regarding claim 27 Kawai et al disclose: The system of claim 26, wherein the network communication link is an internet communication link (note column 8 lines 25-35).

Regarding claim 28 Kawai et al disclose: The system of claim 19, further comprising: a print processing data storage system configured to communicate with the print processing system controller and store the advertisements therein (note abstract, lines 1-19).

Regarding claim 29 Kawai et al disclose: The method of claim 11, wherein the profile of the advertisements includes at least one of keywords and a theme for each of the advertisements (note column 10 lines 49-67).

Regarding claim 30 Kawai et al disclose: The method of claim 11, wherein determining the content of the print job includes determining a profile for the print job based on at least one of keywords and a theme of the print job (note column 9 lines 23-34).

Regarding claim 31 Kawai et al disclose: The system of claim 19, wherein the profile of the advertisements includes at least one of keywords and a theme for each of the advertisements (note column 6 lines 32-59).

Regarding claim 32 Kawai et al disclose: The system of claim 19, wherein the content of the print job is determined from a profile for the print job as based on at least one of keywords and a theme of the print job (note column 8 lines 46-67).

Allowable Subject Matter

4. Claims 15 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Contact Information

➤ Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (571) 272-7462. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (571) 272-7471.

Any response to this action should be mailed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

Or faxed to:

(571) 273-8300, (for *formal* communications; please mark
“**EXPEDITED PROCEDURE**”)

Or:

(703) 306-5406 (for *informal* or *draft* communications, please label
“**PROPOSED**” or “**DRAFT**”)

Hand delivered responses should be brought to Knox building on 501 Dulany Street, Alexandria, VA.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy

Patent Examiner

Group Art Unit 2625

March 16, 2007

